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Application Number

10/671,310

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September 25, 2003

First Named Inventor

Takayuki Yajima

Art Unit

2683

Examiner Name

Meless Zewdu

Attorney Docket Number

848075/0057

ENCLOSURES (Check all that apply)☐

Fee Transmittal Form

☐

Fee Attached

☐

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

☐

Extension of Time Request

☐

Express Abandonment Request

☐

Information Disclosure Statement

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Certified Copy of Priority Document(s)

☐Reply to Missing Parts/
Incomplete Application☐Reply to Missing Parts
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Drawing(s)

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Petition

☐Petition to Convert to a
Provisional Application☐

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

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Signature

Printed name

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Date

December 4, 2006

Reg. No.

55,799

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant:	Takayuki Yajima	Examiner:	Meless Zewdu
Application No.:	10/671,310	Confirmation No.:	8023
Filed:	September 25, 2003	Group Art Unit:	2683
For:	PORTABLE TERMINAL WITH DISPLAY		

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF (UNDER 37 C.F.R. 41.37)

Appellant appeals the Examiner's final rejection dated February 3, 2006.

I. REAL PARTY IN INTEREST

The real party in interest is the assignee Kyocera Corporation.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-18 are under consideration. Claims 1, 2, 4, 5, 7, 8, 11, 12 and 15-17 stand rejected under 35 U.S.C. §102(e) as being allegedly anticipated by U.S. Patent No. 6,907,276 B2 (hereinafter "Toba"). Claims 9, 10, 13, 14 and 18 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Toba in view of U.S. Publication No. 2002/0119768 to Matsumoto (hereinafter "Matsumoto"). The Claims on Appeal appear in Exhibit A attached

hereto. A copy of the Final Office Action of February 3, 2006 appears as Exhibit B attached hereto.

IV. STATUS OF AMENDMENTS

An Amendment submitted on November 22, 2005 in response the Non-Final Office Action of August 22, 2005 was entered. An amendment submitted on August 3, 2006 in response to the Final Office Action of February 3, 2006 was not entered as it was filed with a Notice of Appeal. Therefore, the Amendment was not considered by the Examiner.

V. SUMMARY OF INVENTION

The present claimed invention is a portable terminal that allows unnecessary operations to be omitted by automatically switching (including mode switching) to an input screen in accordance with an opening operation that is required for character input. It also provides a portable terminal that is user friendly.

In general, in a first aspect, the invention features a portable terminal including a first housing having at least a display unit and a second housing having at least an input unit, wherein both housings are openably and closably connected together such that the display unit is visible to the user in at least a closed state. The portable terminal further includes a detecting device for detecting an opening action of either housing and a control device for controlling a screen of the display unit. When the detecting device detects an opening action of either housing, the control device changes a screen on the display unit to an input screen.

In general, in a second aspect, the invention features a portable terminal including a first housing having at least a display unit and a second housing having at least an input unit, wherein both housings are openably and closably connected together so that the display unit is visible to

the user in a closed state and an opened state, and the input unit is visible to the user in an open state. The portable terminal further includes a detecting device for detecting an opening action of either housing and a control device for controlling a screen of the display unit. When the detecting device detects an opening action of either housing, the control device changes a screen on the display unit to an input screen.

In general, in a third aspect, the invention features a portable terminal including a first housing having at least a display unit and a second housing having at least an input unit, wherein both housings are openably and closably connected together so that the display unit is visible to the user in a closed state. The portable terminal further includes a detecting device for detecting an opening action of either housings, and a control device for switching between a non-input mode and an input mode. When the detecting device detects an opening action of either housing, the control device switches the mode from the non-input mode to the input mode.

In general, in a fourth aspect, the invention features a portable terminal including a first housing having at least a display unit and a second housing having at least an input unit, wherein both housings are openably and closably connected together so that the display unit is visible to the user in a closed state. The portable terminal further includes a detecting device for detecting an opening action of either housing, a reception device for receiving e-mail, and a control device for displaying the received e-mail on a screen of the display unit and changing a screen of the display unit. When the detecting device detects an opening action of either housing, the control device changes from a non-input screen displaying the received e-mail to an input screen for composing a reply based on the received e-mail.

In general, in a fifth aspect, the invention features a method of displaying an input screen of a display unit of a portable terminal having housings openably and closably connected

together. The method includes the steps of selecting an item to be displayed on the display unit in a closed state, and changing a non-input screen with the selected item thereon to an input screen corresponding to the item when either housing is opened from a closed state by a user.

In general, in a sixth aspect, the invention features a method of displaying an input screen of a display unit of a portable terminal having housings openably and closably connected together. The method includes the steps of receiving an e-mail, displaying the received e-mail on a non-input screen of the display unit, and changing the non-input screen displaying the received e-mail to the input screen for composing a reply based on the received e-mail when either housing is opened from a closed state by a user.

VI. ISSUES

1. Whether claims 1, 2, 4, 5, 7, 8, 11, 12 and 15-17 are anticipated under 35 U.S.C. §102(e) by the Toba reference.
2. Whether claims 9, 10, 13, 14 and 18 were properly rejected under 35 U.S.C. §103(a) as unpatentable over the Toba reference in view of Matsumoto.

VII. GROUPING OF CLAIMS

Claims 10, 11 and 12 will stand or fall together. Claims 13 and 15-18 will stand or fall together. Claims 19-21 will stand or fall together. Claims 22-25 will stand or fall together. Claims 26-29 will stand or fall together. Claims 30-32 will stand or fall together.

VIII. ARGUMENT

A. ANTICIPATION, 35 U.S.C. §102

1. THE BURDEN IS ON THE PATENT OFFICE TO SHOW THAT APPELLANT IS NOT ENTITLED TO A PATENT

The Patent Statute 35 U.S.C. §102 states: "A person shall be entitled to a patent unless . . ." Thus, the burden is on the Patent Office to prove that an Appellant is not entitled to a patent. According to the MPEP, the Patent Office bears the initial burden of factually supporting any conclusion of anticipation or prima facie case of obviousness.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipissimis verbis* test, i.e. identity of terminology is not required. *In re Bond*, 970 F.2d 831 (Fed. Cir. 1990). The Examiner has not shown that all of the elements contained in the rejected claims are contained in the cited prior art, and therefore the rejections should be reversed.

2. CLAIMS 22-25 REQUIRE A POSITION DETECTING MEANS.

The Final Office Action at page 2 states that Claims 22-25 are rejected as being anticipated by Tomii because Tomii discloses *inter alia* the combination of a present location recognition means and present location recognition memory. The Examiner asserts that this is analogous to the position detecting means disclosed in Claims 22-25. Tomii, however, fails to teach position detection based upon a signal received by the mobile communication terminal. The translation of Tomii describes the recognition means as a control means for "recognizing the contents of registration . . . [in] present location recognition memory", where the user inputs the contents of "registration". The Examiner recognized in the Final Office Action that the Tomii reference requires that the user input the current position of the mobile communication terminal.

At paragraph 1, page 3, the Examiner recognized that the Tomii position detecting section detects the current position "through a user's key input actuation, the key input actuation by the user reading in the claimed signal received by said mobile communications terminal."

In the position detecting means claimed in independent Claim 22 of the application, however, the location information does not have to be pre-registered or input by the user. The current position in Applicant's claimed invention is determined by a signal received by the mobile communication terminal. User input is not a signal as required by the claim language. The signal is an independent signal received from a base station or similar source. In the system described in Tomii, the user of the communication terminal has to set the current position by hand every time he changes location, while the invention as claimed in Claims 22-25, the user does not need to set the current position, as it is updated automatically by the position detection means as soon as he changes location. Tomii does not disclose this feature.

Thus, the rejections of Claims 22-25 for anticipation should be reversed.

3. CLAIMS 26, 27, 29, 30 AND 32 REQUIRE STORAGE OF A RECEIVED CALL NUMBER

The Final Office Action states at page 4 and 5 that Claims 26, 27 and 30 are rejected as being anticipated by Suominen because Suominen discloses a method for storing a received call number comprising certain steps. Claims 29 and 32 are dependant on claims 27 and 30, respectively, and are rejected for the same reasons with the additional statement that Suominen discloses storing country indicator input by the user in a received call history separate from the call number. However, Suominen discloses a method involving input of both the numbers and the country indicator by the user for later use.

Suominen explains at column 3, lines 31-34 that the stored call number is a telephone number to be stored in the abbreviated dialing memory by entering the telephone number using the telephone keys in a conventional manner. The Examiner recognized this number is a telephone number "imputed by the user in the mobile telephone for storage in the memory." Thus, Suominen simply refers to retrieving a phone number which the user has typed in for the specific purpose of being recalled. The invention claimed in Claims 26, 27, 29, 30 and 32 however, addresses storing a number of a call received by the mobile telephone from an external source and assigning it a number in the call history.

Further, Suominen discloses storing a history of call numbers entered by the user. Claims 29 and 32 claim a received call number history which stores call numbers of telephone calls received by the mobile telephone from an external source.

Thus, the rejections of Claims 26, 27, 29, 30 and 32 for anticipation should be reversed.

B. OBVIOUSNESS, 35 U.S.C. §103

1. THE FINAL REJECTION OF CLAIMS 10 AND 12 FOR OBVIOUSNESS FAILS TO CITE A REFERENCE FOR THE MISSING ELEMENTS

With respect to Claim 10, the Final Office Action states: "it would have been obvious for a person of ordinary skill in the art at the time the invention was made to stored[sic] the telephone number disclosed by Suominen in a performed call history as taught by Rogers for the purpose of conveniently recall[sic] said performed call number for further dialing." However, no evidence was set forth that either reference disclosed a method for storing a performed call number whereby the international call identification number of an international call was automatically excluded from the number as stored in order to have a uniformity of stored numbers.

As acknowledged by the Examiner, Suominen does not disclose storing a performed telephone call number in a performed call history, and Rogers only discloses prepending digits to a number, not automatically removing digits from a number for storage. Further, Rogers requires that the user enable the prefixes for specific types of calls before the prefix will be attached. The invention as claimed in Claim 10 allows for the automatic storage of the international call with the international call identification number stored separately, which allows the stored numbers to be used as either national or international call numbers, as appropriate based on the location of the phone. The invention allows the phone to append the necessary international call number without separate input by the user. It would not have been known to persons having ordinary skill in the art to store international call numbers automatically in a performed call history without the international call identification number.

Thus, the rejections of Claim 10 for obviousness should be reversed.

Since Claim 12 depends from Claim 10, it is not obvious for at least the same reasons as set forth with respect to Claims 10.

2. THE FINAL REJECTION OF CLAIMS 11 AND 19-21 FOR OBVIOUSNESS FAILS TO CITE A REFERENCE FOR THE MISSING FEATURES

With respect to claim 11, the Final Office Action states: "it would have been obvious for a person of ordinary skill in the art at the time the invention was made to incorporate the selection of the country code (nation number) based on a signal received by the mobile communication terminal as taught by Tomii in the method disclosed by Suominen, as modified by Rogers, for the purpose of faster storage and processing. Claim 11 is dependant on Claim 10, and the Examiner's rejection of Claim 11 based on the combination of Suominen and Rogers should be reversed for the same grounds as Claims 10 and 12. Additionally, as discussed above

in connection with Claims 22-25, the system described in Tomii requires the user of the communications terminal to set the current position of the terminal by manual input when the location of the unit is changed. However, the invention as defined in Claim 11 the current position is determined by an external signal received by the mobile communication terminal from a base station or similar source.

The Examiner recognized that Tomii requires that the current position is detected through a user's key input action. No evidence was set forth that any of the references disclosed a method for determining the current location of the mobile telephone based upon a signal received by the mobile communication terminal from a base station or similar source.

Thus, the rejection of Claim 11 for obviousness should be reversed.

Since Claims 19-21, depend from Claim 11, they are not anticipated nor obvious for at least the same reasons as set forth with respect to Claims 11.

3. THE FINAL REJECTION OF CLAIMS 13 AND 15-18 FOR OBVIOUSNESS FAILS TO CITE A REFERENCE FOR THE MISSING FEATURES

With respect to Claim 13, the Final Office Action states: "it would have been obvious for a person of ordinary skill in the art at the time the invention was made to stored[sic] the telephone number disclosed by Tomii in a performed call history as taught by Rogers for the purpose of conveniently recall[sic] said performed call number for further dialing."

One of the elements of Claim 13 is the step of "obtaining a nation number based on the current position of a mobile communication terminal detected from a signal received by said mobile communication terminal." As discussed above in connection with Claims 22-25, the system described in Tomii requires the user of the communications terminal to set the current position of the terminal by manual input when the location of the unit is changed, and the system

described in Rogers does not disclose detection of the current position of the mobile unit.

However, the invention as defined in Claim 13 the current position is determined by an external signal received by the mobile communication terminal from a base station or similar source.

Thus, the rejection of Claim 13 for anticipation should be reversed.

Since Claims 15-18, depend from Claims 13, they are not anticipated nor obvious for at least the same reasons as set forth with respect to Claim 13.

4. THE FINAL REJECTION OF CLAIMS 28 AND 31 FOR OBVIOUSNESS FAILS TO CITE A REFERENCE FOR THE MISSING FEATURES

With respect to Claim 28, the Final Office Action states: "it would have been obvious for a person of ordinary skill in the art at the time the invention was made to incorporate the selection of the country code (nation number) based on a signal received by the mobile communication terminal as taught by Tomii in the method disclosed by Suominen for the purpose of faster storage and processing."

With respect to Claim 31, the Final Office Action states: "it would have been obvious for a person of ordinary skill in the art at the time the invention was made to incorporate the position detecting section taught by Tomii in the terminal disclosed by Suominen for the purpose of providing local position detection determination and faster originating processing."

Since Claims 28 and 31, depend from Claim 27 and 30, respectively, they are not anticipated nor obvious for at least the same reasons as set forth with respect to Claims 27 and 30. Additionally, as discussed above in connection with Claims 22-25, the system described in Tomii requires the user of the communications terminal to set the current position of the terminal by manual input when the location of the unit is changed, and the system described in Rogers does not disclose detection of the current position of the mobile unit. However, the invention as

defined in Claims 28 and 31 the current position is determined by an external signal received by the mobile communication terminal from a base station or similar source.

Thus, the rejection of Claims 28 and 31 for obviousness should be reversed.

**5. THE PURPORTED OBVIOUSNESS REJECTIONS FAIL TO MEET
MINIMUM MPEP REQUIREMENTS FOR A PROPER STATEMENT OF
REJECTION**

Claims 10-13, 15-21, 28 and 31 are rejected for obviousness.

The MPEP sets out a form for the reasoning under which claims are to be examined for obviousness. After the difference between the claim and the prior art has been determined under the first steps of the *John Deere* analysis, the MPEP instructs how to analyze the “obviousness of the difference” between a claim and the prior art. An overview of this analysis is stated at § 2143 (and, is repeated twice more in §§ 706.02(j) and 2142). Note that, in two short paragraphs, the MPEP reiterates five times that this form of reasoning is mandatory. This, and no other, is the form of reasoning that must be used (emphasis added):

2143 Basic Requirements of a *Prima Facie* Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Appellant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Further requirements of these three reasoning steps are elaborated in §§2143.01-2143.03, and the permissible “Sources of Rationale” that must underlie each of the steps are set out in §§ 2144-2144.09.

The written rejection simply states that it would have been "obvious" to combine the references, but makes no attempt to make the underlying showings of a suggestion or motivation to modify any of the cited references. Because the written rejection fails to even make a facial attempt to be complete, the § 103(a) rejection are improper.

If the claims remain rejected, the Examiner should be instructed that his written rejection must state specific findings on each of the required elements of a *prima facie* case, at least to the degree that issues have been traversed in any of Appellant's previous papers. Any further rejection should set out this analysis in writing so that Appellant can respond with appropriate claim amendments or arguments. The Board is requested to supervise the Examiner to ensure that any future obviousness rejection follows the form of reasoning set out at MPEP §§ 2143-2143.03.

6. THERE IS NO MOTIVATION TO COMBINE THE ELEMENTS OF ANY OF SUOMINEN, TOMII AND ROGERS

Claims 10 and 12 are rejected based upon a combination of Suominen and Rogers. Claims 11 and 19-21 are rejected based upon a combination of Suominen, Rogers and Tomii. Claims 13 and 15-18 are rejected based on a combination of Tomii and Rogers. Finally, Claims 28 and 31 are rejected based upon a combination of Suominen and Tomii. It would not have been obvious to combine the elements of Suominen with Rogers, Suominen with Tomii, or Tomii with Rogers to achieve the present invention. In fact, Rogers is only cited for the automatic prepending of digits to a call number, and does not eliminate the deficiency that Suominen does not disclose using its storage system for a performed call number. Further, neither Rogers nor Suominen overcome the flaw that Tomii requires the user to set the current position by manual input, and does not receive current location data from an external signal. For

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the same reason, Tomii cannot eliminate the deficiencies of Rogers or Suominen in connection with current location position detection.

IX. CONCLUSION

For the foregoing reasons, it is respectfully submitted that the Final Rejection of Claims 1-18 should be reversed.

Respectfully submitted,

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Dated: December 4, 2006
New York, New York



Exhibit A

Claims on Appeal

Claim 1: A portable terminal having an open state and a closed state, said portable terminal comprising:

- a first housing having at least a display unit with a screen;
- a second housing having at least an input unit;
- a detecting unit for detecting opening of either of said housings; and
- a control unit for controlling said screen of said display unit;

wherein said first housing is openably and closably connected to said second housing, wherein said display unit is visible to a user in at least said closed state of said portable terminal, and wherein, when said detecting unit detects opening of either of said housings, said control unit changes said screen of said display unit to an input screen.

Claim 2: The portable terminal according to claim 1 further comprising a selecting unit for selecting an item displayed on said display unit, wherein when said detecting unit detects opening of either of said housings, said control device changes said screen with an item selected by said selecting unit to an input screen corresponding to said item.

Claim 3: The portable terminal according to claim 1, wherein said portable terminal is a personal digital assistant.

Claim 4: The portable terminal according to claim 1, wherein said portable terminal is a portable telephone.

Claim 5: A portable terminal having a closed state and an open state, said portable terminal comprising:

- a first housing having at least a display unit with a screen;
- a second housing having at least an input unit;
- a detecting unit for detecting opening of either of said housings; and
- a control unit for controlling said screen of said display unit;

wherein said first and said second housings are openably and closably connected together, wherein said display unit is visible to the user in said closed state and in said open state of said portable terminal, wherein said input unit is visible to a user in said open state, and wherein, when said detecting unit detects opening of either of said housings, said control unit changes said screen of said display unit to an input screen.

Claim 6: The portable terminal according to claim 5, wherein said portable terminal is a personal digital assistant.

Claim 7: The portable terminal according to claim 5, wherein said portable terminal is a portable telephone.

Claim 8: A portable terminal having a closed state and an open state, said portable terminal comprising:

- a first housing having at least a display unit, said display unit being switchable between an input mode and a non-input mode;

- a second housing having at least an input unit;

- a detecting unit for detecting opening of either of said housings; and

- a control unit for switching said display unit between said non-input mode and said input mode;

wherein said housings are openably and closably connected together, wherein said display unit is visible to a user in said closed state of said portable terminal, and wherein when said detecting unit detects opening of either of said housings, said control unit switches said display unit from said non-input mode to said input mode.

Claim 9: A portable terminal having a closed state and an open state, said portable terminal comprising:

- a first housing having at least a display unit, said display unit including a screen changeable between an input screen and a non-input screen;

- a second housing having at least an input unit;

a detecting unit for detecting opening of either of said housings;
a reception unit for receiving an electronic mail message; and
a control means for selectively displaying said received electronic mail message on said screen of said display unit and for changing said screen of said display unit;

wherein said housings are openably and closably connected together, wherein said display unit is visible to a user in said closed state, and wherein when said detecting unit detects opening of either of said housings, said control unit changes said non-input screen displaying said received e-mail to said input screen for editing based on said received e-mail.

Claim 10: The portable terminal according to claim 9, wherein said control unit changes said non-input screen displaying said received e-mail to said input screen and displays said received e-mail on said input screen.

Claim 11: A method of displaying an input screen of a display unit of a portable terminal having housings openably and closably connected together, comprising the steps of:

selecting an item to be displayed on said display unit while said portable terminal is in a closed state; and

changing a non-input screen of said display unit having an item selected thereon to an input screen corresponding to said selected item when either of said housings is opened from said closed state.

Claim 12: The method according to claim 11, wherein said non-input screen has a guide view informing a user to open either of said housings from said closed state.

Claim 13: A method of displaying an input screen of a display unit of a portable terminal having housings openably and closably connected together, comprising the steps of:

receiving an electronic mail message;

displaying said received electronic mail message on a non-input screen of said display unit; and

changing said non-input screen displaying said received electronic mail message to an input screen for editing based on said received electronic mail message when either of said housings is opened from its closed state.

Claim 14: The method according to claim 13, wherein said non-input screen has a guide view informing a user to open either of said housings from said closed state.

Claim 15: A portable terminal having an open state and a closed state, said portable terminal comprising:

- a first housing having a display unit with a screen;
- a second housing having an input unit;
- a detecting unit for detecting opening of either of said housings; and
- a control unit for controlling said screen of said display unit;

wherein said first housing is openably and closably connected to said second housing, wherein said display unit is visible to a user in at least said closed state of said portable terminal, and wherein, when said detecting unit detects opening of either of said housings, said control unit changes said screen of said display unit to an input screen.

Claim 16: A portable terminal having a closed state and an open state, said portable terminal comprising:

- a first housing having a display unit with a screen;
- a second housing having an input unit;
- a detecting unit for detecting opening of either of said housings; and
- a control unit for controlling said screen of said display unit;

wherein said first and said second housings are openably and closably connected together, wherein said display unit is visible to the user in said closed state and in said open state of said portable terminal, wherein said input unit is visible to a user in said open state, and wherein, when said detecting unit detects opening of either of said housings, said control unit changes said screen of said display unit to an input screen.

Claim 17: A portable terminal having a closed state and an open state, said portable terminal comprising:

- a first housing having a display unit, said display unit being switchable between an input mode and a non-input mode;

- a second housing having an input unit;
- a detecting unit for detecting opening of either of said housings; and
- a control unit for switching said display unit between said non-input mode and said input mode;

wherein said first and said second housings are openably and closably connected together, wherein said display unit is visible to the user in said closed state of said portable terminal, and wherein when said detecting unit detects opening of either of said housings, said control unit switches said display unit from said non-input mode to said input mode.

Claim 18: A portable terminal having a closed state and an open state, said portable terminal comprising:

- a first housing having a display unit, said display unit with a screen changeable between an input screen and a non-input screen;

- a second housing having an input unit;

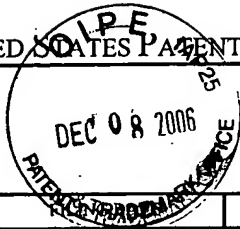
- a detecting unit for detecting opening of either of said housings;

- a control unit for selectively displaying said received electronic mail message on said screen of said display unit and for changing said screen of said display unit;

wherein said housings are openably and closably connected together, wherein said display unit is visible to the user in said closed state, and wherein when said detecting unit detects opening of either of said housings, said control unit changes said non-input screen displaying said received e-mail to said input screen for editing based on said received e-mail.

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APPLICATION NO.	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/671,310

09/25/2003

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EXAMINER

ZEWDU, MELESS NMN

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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SCHULTE ROTH & ZABEL LLP



Office Action Summary

10/671,310

YAJIMA, TAKAYUKI

Examiner

Art Unit

Meless N. Zewdu

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. This action is in response to the communication filed on 11/25/05.
2. Claims 15-18 have been added in the instant amendment.
3. Claims 1-18 are pending in this action.
4. The title of the disclosure submitted with the current amendment has been approved by examiner.
5. This action is final.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims ~~1~~, ~~2~~, ~~4~~, ~~5~~, ~~7~~, ~~8~~, ~~11~~, ~~12~~ and ~~15~~-~~17~~ are rejected under 35 U.S.C. 102(e) as being anticipated by Toba (US 6,907,276 B2). For examination purposes, claim 11 is considered firs.

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As per claim 11: Toba discloses a method of displaying an input screen of a display unit of a portable terminal having housings open-ably and close-ably connected Together (see figs. 1 and 2; col. 6, lines 48-58), comprising the steps of:

selecting an item to be displayed on said display unit while said portable terminal is in a closed state (see col. 6, line 59-col. 7, line 2; col. 7, line 58-col. 8, line 6; col. 12, lines 23-56; col. 19, lines 5-53;). Scrolling (see col. 12, lines 49-56) is a means of selecting an item to be displayed.

changing a non-input (external) screen of said display unit having an item selected thereon to an input screen corresponding to said selected item when either of said housings is opened from said closed state (see 8, lines 37-49).

As per claim 12: Toba discloses a method, wherein said non-input (external) screen has a guide view informing a user to open either of said housings from said closed state (see fig. 2, element 11; col. 7, line 67-col. 8, line 6).

As per claim 1: Toba discloses a portable terminal having an open state and a closed state (see figs. 1 and 2; col. 6, lines 48-58), said portable terminal comprising:

a first housing having at least a display unit with a screen (see fig. 1, elements 3 and 5; col. 6, line 59-col. 7, line 2);

a second housing having at least an input unit (see fig. 1, elements 4 and 8; col. 6, line 59-col. 7, line 2);

a detecting means for detecting opening of either of said housings (see fig. 1, element 6; col. 6, line 59-col. 7, line 2; col. 4, lines 39-65); and

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a control means for controlling said screen of said display unit (see col. 3, lines 38-53; col. 7, line 58-col. 8, line 6; col. 8, lines 28-49);

wherein said first housing is open-ably and close-ably connected to said second housing (see figs. 1 and 2; col. 6, lines 48-58), wherein said display unit is visible to a user in at least said closed state of said portable terminal (see fig. 2, element 11; col. 6, line 59-col. 7, line 2), and wherein, when said detecting means detects opening of either of said housings, said control means changes said screen of said display unit to an input screen (main display) (see col. 6, line 47-col. 7, line 2; col. 7, line 58-col. 8, line 6; col. 8, lines 27-49).

As per claim 2: Toba discloses a portable terminal, further comprising:

a selecting unit (fig. 3, element 21) for selecting an item displayed on said display unit (see col. 12, lines 45-56) (wherein scrolling indicates selection); wherein when said detecting means detects opening of either of said housings, said control device changes said screen with an item selected by said selecting unit to an input screen corresponding to said item (see col. Col. 3, lines 38-53; col. 8, line 27-49).

As per claim 4: Toba discloses a portable terminal, wherein said portable terminal is a portable telephone (see fig. 1; abstract; col. 6, line 47-col. 7, line 2).

As per claim 15: the features of claim 15 are similar to the features of claim 1. Hence, claim 15 is rejected on the same ground as claim 1.

As per claim 16: the features of claim 16 are similar to the features of claim 1. Hence, claim 16 is rejected on the same ground as claim 1.

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As per claim 17: the features of claim 17 are similar to the features of claim 1. Hence, claim 17 is rejected on the same ground as claim 1.

As per claim 5: Toba discloses a portable terminal having a closed state and an open state (see figs. 1 and 2; col. 6, lines 48-58), said portable terminal comprising:

a first housing having at least a display unit with a screen (see fig. 1, elements 3 and 5; col. 6, line 59-col. 7, line 2);

a second housing having at least an input unit (see fig. 1, elements 4 and 8; col. 6, line 59-col. 7, line 2);

a detecting means for detecting opening of either of said housings (see fig. 1, element 6; col. 6, line 59-col. 7, line 2; col. 4, lines 39-65); and

a control means for controlling said screen of said display unit (see col. 3, lines 38-53; col. 7, line 58-col. 8, line 6; col. 8, lines 28-49);

wherein said first and said second housings are open-ably and close-ably connected together (see figs. 1 and 2; col. 6, lines 48-58), wherein said display unit is visible to the user in said closed state and in said open state of said portable terminal (see fig. 1, element 5 and fig. 2, element 11; col. 6, line 59-col. 7, line 2), wherein said input unit is visible to a user in said open state, and wherein, when said detecting means detects opening of either of said housings, said control means changes said screen of said display unit to an input screen (main display) (see col. 6, line 47-col. 7, line 2; col. 7, line 58-col. 8, line 6; col. 8, lines 27-49).

As per claim 7: Toba discloses a portable terminal, wherein said portable terminal is a portable telephone (see fig. 1; abstract; col. 6, line 47-col. 7, line 2).

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As per claim 8: Toba discloses a portable terminal having a closed state and an open state (see figs. 1 and 2; col. 6, lines 48-58), said portable terminal comprising:

a first housing having at least a display unit, said display unit being switchable between an input mode and a non-input mode (see fig. 1, element 5 and fig. 2, element 11; col. 6, lines 47-58; col. 8, lines 28-49);

a second housing having at least an input unit (see fig. 1, elements 4 and 8; col. 6, line 59-col. 7, line 2);

a detecting means for detecting opening of either of said housings (see fig. 1, element 6; col. 6, line 59-col. 7, line 2; col. 4, lines 39-65); and

a control means for switching said display unit between said non-input mode and said input mode (see col. 3, lines 38-53; col. 7, line 58-col. 8, line 6; col. 8, lines 28-49). Note: the non-input and input modes displays correspond to the main and supplemental displays of the prior art.

wherein said housings are openably and closably connected together (see figs. 1 and 2), wherein said display unit is visible to a user in said closed state of said portable terminal (see fig. 2, element 11) , and wherein when said detecting means detects opening of either of said housings (col. 7, lines 16-30), said control means switches said display unit from said non-input mode to said input mode (main display mode) (see col. 6, line 47-col. 7, line 2; col. 7, line 58-col. 8, line 6; col. 8, lines 27-49).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims ~~9~~, 10, 13, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toba in view of Matsumoto et al. (Matsumoto) (US 2002/0119768

A1). For examination purpose, claim 13 is considered first.

As per claim 13: Toba discloses a method of displaying an input screen of a display unit of a

portable terminal having housings open-ably and close-ably connected

together (see figs. 1 and 2; col. 6, lines 48-58), comprising the steps of:

receiving an electronic mail message (see abstract; col. 3, lines 22-36);

displaying said received electronic mail message on a non-input (external)

screen of said display unit (see fig. 2, element 11; col. 3, lines 22-36; col. 7, line 58-col.

8, line 6); and

changing said non-input screen displaying said received electronic mail message to an input screen (see col. 8, lines 27-49). Further more, Toba discloses displaying received electronic mail message when either of said housings is opened from its closed state (see col. 3, lines 38-53). But, Toba does not explicitly teach/disclose about editing the received email/electronic mail message, as claimed by

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applicant. However, in a related field of endeavor, Matsumoto teaches about portable terminal (mobile station/telephone (see fig. 1) wherein a user of the mobile station may use a text editing function, such as electronic mail (email) which is provided for the mobile station (see page 1, paragraphs 008-009). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Toba with that of Matsumoto for the advantage of conveying information/message to a party without omission (see page 1, paragraph 008).

As per claim 14: Toba discloses a method, wherein said non-input (external) screen has a guide view informing a user to open either of said housings from said closed state (see fig. 2, element 11; col. 7, line 67-col. 8, line 6).

As per claim 18: the features of claim 18 are similar to the features of claim 9. Hence, claim 18 is rejected on the same ground and motivation as claim 9.

As per claim 9: Toba discloses a portable terminal having a closed state and an open state (see figs. 1 and 2; col. 6, lines 48-58) said portable terminal comprising:

a first housing having at least a display unit, said display unit including a screen changeable between an input screen and a non-input screen (see figs. 1 and 2 and corresponding elements 5 and 11). Note: elements 5 and 11 correspond to the input and non-input display modes/screens (see also abstract; col. 7, line 58-col. 8, line 6; col. 8, lines 27-36).

a second housing having at least an input unit (see fig. 1, elements 4 and 8; col. 6, line 59-col. 7, line 2);

a detecting means for detecting opening of either of said housings see fig. 1, element 6; col. 6, line 59-col. 7, line 2; col. 4, lines 39-65); and

a reception means for receiving an electronic mail message (see abstract; col. 7, line 41-col. 8, line 6); and

a control means for selectively displaying said received electronic mail message on said screen of said display unit (see abstract; col. 7, lines 16-30; col. 7, line 58-col. 8, line 6), and for changing said screen of said display unit (col. 8, lines 27-49); wherein said housings are openably and closably connected together (see figs. 1 and 2; col. 6, lines 48-58), wherein said display unit is visible to a user in said closed state (see fig. 1, element 5 and fig. 2, element 11; col. 6, line 59-col. 7, line 2), and wherein when said detecting means detects opening of either of said housings (see fig. 1, element 6; col. 6, lines 48-58; col. 7, lines 16-30), said control means changes said non-input screen displaying said received e-mail to said input screen (main screen) (see col. 8, lines 21-49). In summary, the prior art discloses a detection means for detecting whether the first and second housings are in an open or closed mode and a control for displaying electronic mail/ email message based on the detected mode of display and further a switch for switching the display mode between the two modes. But, Toba does not explicitly teach about editing a received email, as claimed by applicant. However, in a related field of endeavor, Matsumoto teaches about portable terminal (mobile station/telephone (see fig. 1) wherein a user of the mobile station may use a text editing function, such as electronic mail (email) which is provided for the mobile station (see page 1, paragraphs 008-009). Therefore, it would have been obvious for one of ordinary

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skill in the art at the time the invention was made to modify the teaching of Toba with that of Matsumoto for the advantage of conveying information/message to a party without omission (see page 1, paragraph 008).

As per claim 10: Toba teaches about a portable terminal, wherein said control means changes said non-input screen displaying said received e-mail to said input screen and displays said received e-mail on said input screen (see abstract; col. 7, line 58-col. 8, line 6; col. 8, lines 27-49).

Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toba as applied to claim 1 above, and further in view of Lenchik et al. (Lenchik) (US 6,658,272 B1).

As per claim 3: but, Toba does not explicitly teach about a portable terminal, according to claim 1, wherein said portable terminal is a personal digital assistant, as claimed by applicant. However, in a related field of endeavor, Lenchik teaches about a self configured portable electronic device, that can be configured as a personal digital assistant (figs 5- 8; col. 3, lines 13-40) and a cellular telephone (see col. 2, line 2-col. 3, line 12). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Toba with that of Lenchik (configuring portable terminal into PDA) for the advantage of using large display the PDA provides (see col. 1, lines 10-24).

As per claim 6: but, Toba does not explicitly teach about a portable terminal, according to claim 1, wherein said portable terminal is a personal digital assistant, as claimed by applicant. However, in a related field of endeavor, Lenchik teaches about a self

configured portable electronic device, that can be configured as a personal digital assistant (figs 5- 8; col. 3, lines 13-40) and a cellular telephone (see col. 2, line 2-col. 3, line 12). The motivation same as provided in the rejection of claim 3.

Response to Arguments

Applicant's arguments filed on 11/25/05 have been fully considered but they are not persuasive. Applicant's arguments and examiner's respective responses are shown below in an indexed fashion.

Argument I: with regard to claims 1, 5, 8 and 11, applicant argues by saying Toba fails to show or suggest switching the non-input screen visible in the portable terminal's closed state to the input screen visible in the portable terminal's open state.

Response I: Examiner respectfully disagrees with the argument. In that, Toba's reference provides a mobile terminal with a non-input (closed state) screens and input (open state screen) comprised of a Hall element, which carries out switching operation based on a magnet arranged on a corresponding position of the housing (see col. 7, lines 16-30). Applicant further attempts to support the argument with exemplary features that were not claimed, and therefore could not be considered. Hence, the argument is found not to be persuasive.

Argument II: With regard to claims mentioned above, particularly claim 1, applicant still argues by saying, Toba simply teaches that a non-input screen shown on an external display in the mobile communication terminal's closed state is shown on the internal or

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main display unit when the mobile communication terminal is opened. Thus Toba fails to teach or suggest the limitation stating that "when said detecting means detects opening of either of said housings, said control means changes said screen of said display unit to an input screen."

Response II: examiner respectfully disagrees with the argument. Toba's reference (see fig. 3, elements 6 and 21), includes a detecting means and a control means for switching a display screen from a closed state to an open state (see col. 8, lines 27-36).

The argument, therefore, is moot.

Argument III: with regard to claims 9, 10, 13 and 14, applicant argues by saying that neither Toba nor Matsumoto, either individually or in combination, suggest to someone skilled in the art switching a screen from a non-input mode to an input mode when the user opens the previously closed portable terminal.

Response III: examiner respectfully disagrees with the argument. In that Toba, as discussed above, teaches about changing a display screen from a non-input (closed mode) to an input screen (open mode) with the help of a detector and a controller. Furthermore, Toba also teaches that the housing/s of the terminal is/are open-able by the user, while advantageously allowing the user to confirm a received message in the closed state (see col. 1, lines 28-34; col. 19, lines 41-53). Matsumoto is brought to the combination for providing/teaching about editing a received mail (e-mail) message. Applicant's argument about Matsumoto, not teaching about switching a display screen mode, is a misplaced one. This feature is, as discussed in the body of the rejection of the claims in question, by Toba. And Toba, discloses a display screen that is switch-

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able from non-input to an input mode with the help of a detection and control devices, as discussed elsewhere in the above responses. Hence, the argument is found to be not persuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N. Zewdu whose telephone number is (571) 272-7873. The examiner can normally be reached on 8:30 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceedings should be directed to the receptionist whose telephone number is (571) 272.2600.

Meless zewdu

M. Z.

Examiner

30 January 2006.



WILLIAM TROST
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